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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,489	12/11/2003	Masaki Shimada	534101-8	1605
27799	7590	01/23/2006		
COHEN, PONTANI, LIEBERMAN & PAVANE 551 FIFTH AVENUE SUITE 1210 NEW YORK, NY 10176			EXAMINER FLOURNOY, HORACE L	
			ART UNIT	PAPER NUMBER
			2189	

DATE MAILED: 01/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/734,489	<b>Applicant(s)</b> SHIMADA ET AL.	
	<b>Examiner</b> Horace L. Flournoy	<b>Art Unit</b> 2189	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

The instant application having Application No. **10/734,489** has a total of 16 claims pending in the application; there are 2 independent claims and 14 dependent claims, all of which are ready for examination by the examiner.

## INFORMATION CONCERNING OATH/DECLARATION

### *Oath/Declaration*

The applicant's oath/declaration has been reviewed by the examiner and is found to conform to the requirements prescribed in **37 C.F.R. 1.63**.

## STATUS OF CLAIM FOR PRIORITY IN THE APPLICATION

As required by **M.P.E.P. 201.14(c)**, acknowledgement is made of applicant's claim for priority based on an application filed on December 18, 2002 (Foreign Priority 2002-366229).

## REJECTIONS BASED ON PRIOR ART

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-16** are rejected under 35 U.S.C. 102(b) as being anticipated by **Alera Technologies hereafter referred to as Alera**.

With respect to independent **claim 1**,

*"An information processing apparatus [**"Copy Tower 40"**] having a first insertion/removal portion capable of inserting/removing a first recording medium [**CD-R, e.g.**] and at least reading out electronic information from the inserted first recording medium, [**See Picture. (First drive mechanism)**] a second insertion/removal portion capable of inserting/removing a second recording medium and reading out and writing electronic information from and in the inserted second recording medium, [**"...can simultaneously duplicate up to 3 copies of a typical CD..."**] and an operating member which is connected to the first and second insertion/removal portions so as to be able to exchange electronic information and starts an operation of reading out electronic information recorded on the first recording medium and writing the electronic information in the second recording medium, [**"...includes a "Track-Selecting" function which allows you to combine tracks from different discs into one single disc. This function teaches an operating member, which is connected to all of the disc drives and enables them to exchange electronic information. It also reads out electronic information found on a first disc***

**and writes that information onto another or second disc (recording medium)] comprising:"**

The following limitations of **claim 1** are interpreted under 35 U.S.C. 112, 6<sup>th</sup> paragraph.

The Court of Appeals for the Federal Circuit, in its en banc decision *In re Donaldson Co.*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994), decided that a "means-or-step-plus-function" limitation should be interpreted in a manner different than patent examining practice had previously dictated. The Donaldson decision affects only the manner in which the scope of a "means or step plus function" limitation in accordance with 35 U.S.C. 112, sixth paragraph, is interpreted during examination. Donaldson does not directly affect the manner in which any other section of the patent statutes is interpreted or applied.

When making a determination of patentability under 35 U.S.C. 102 or 103, past practice was to interpret a "means or step plus function" limitation by giving it the "broadest reasonable interpretation." Under the PTO's long-standing practice this meant interpreting such a limitation as reading on any prior art means or step which performed the function specified in the claim without regard for whether the prior art means or step was equivalent to the corresponding structure, material or acts described in the specification. However, in Donaldson, the Federal Circuit stated:

Per our holding, the "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination. (MPEP 2181)

According to the applicant's specification in paragraph [0012], the Examiner notes that the means or system/structure ("**control unit**") for practice of the invention disclosed in the following limitation of Claim 1, is further taught in

**Alera Technologies as follows:**

*"...control means for controlling exchange of electronic information in the information processing apparatus; [**"Copy control Features"** This feature is done by the **"Stand Alone Tower"** and the electronic mechanism(s) there within] and..."*

According to the applicant's specification in paragraph [0012], the Examiner notes that the means or system/structure ("**expression unit**") for practice of the invention disclosed in the following limitation of Claim 1, is further taught in

**Alera Technologies as follows:**

*“...expression means for expressing an operation state of the information processing apparatus, [“Disc Info feature” This feature is done by the “Stand Alone Tower” and the electronic mechanism(s) there within] wherein when a state in which a recording medium is inserted into at least one of the first and second insertion/removal portions and electronic information can be read out or written is detected, said expression means performs expression operation of the state.” [“Copy Tower 40”]*

With respect to independent **claim 2**,

*“An information processing apparatus [“Copy Tower 40”] having a first insertion/removal portion capable of inserting/removing a first recording medium [CD-R, e.g.] and at least reading out electronic information from the inserted first recording medium, [See Picture. (First drive mechanism)] a second insertion/removal portion capable of inserting/removing a second recording medium and reading out and writing electronic information from and in the inserted second recording medium, [“...can simultaneously duplicate up to 3 copies of a typical CD...”] and an operating member which is connected to the first and second insertion/removal portions so as to be able to exchange electronic information and starts an operation of reading out electronic information recorded on the first recording medium and writing the electronic information in the second recording medium, [“...includes a “Track-Selecting” function which allows you to combine tracks from different discs into one single disc. This function teaches an operating member, which is*

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**connected to all of the disc drives and enables them to exchange electronic information. It also reads out electronic information found on a first disc and writes that information onto another or second disc (recording medium)] comprising:"**

The following limitations of **claim 2** are interpreted under 35 U.S.C. 112, 6<sup>th</sup> paragraph.

The Court of Appeals for the Federal Circuit, in its en banc decision *In re Donaldson Co.*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994), decided that a "means-or-step-plus-function" limitation should be interpreted in a manner different than patent examining practice had previously dictated. The Donaldson decision affects only the manner in which the scope of a "means or step plus function" limitation in accordance with 35 U.S.C. 112, sixth paragraph, is interpreted during examination. Donaldson does not directly affect the manner in which any other section of the patent statutes is interpreted or applied.

When making a determination of patentability under 35 U.S.C. 102 or 103, past practice was to interpret a "means or step plus function" limitation by giving it the "broadest reasonable interpretation." Under the PTO's long-standing practice this meant interpreting such a limitation as reading on any prior art means or step which performed the function specified in the claim without regard for whether the prior art means or step was equivalent to the corresponding structure, material or acts described in the specification. However, in Donaldson, the Federal Circuit stated:

Per our holding, the "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination. (MPEP 2181)

According to the applicant's specification in paragraph [0012], the Examiner notes that the means or system/structure ("**control unit**") for practice of the invention disclosed in the following limitation of Claim 1, is further taught in

**Alera Technologies as follows:**

*"...control means for controlling exchange of electronic information in the information processing apparatus; [**"Copy control Features"** This feature is done by the **"Stand Alone Tower"** and the electronic mechanism(s) there within] and..."*

According to the applicant's specification in paragraph [0012], the Examiner notes that the means or system/structure ("**expression unit**") for practice of the invention disclosed in the following limitation of Claim 1, is further taught in

**Alera Technologies as follows:**

*"...expression means for expressing an operation state of the information processing apparatus, [**"Disc Info feature"** This feature is done by the **"Stand Alone Tower"** and the electronic mechanism(s) there within] wherein when a state in which electronic information cannot be read out from or written in a recording medium inserted in at least one of the first and second insertion/removal portions is detected, said expression means performs expression operation of the state."* [**"Copy Tower 40.... Testing feature"**]

**With respect to claims 3 and 4,**

*"An apparatus according to claim 1, wherein said expression means includes a display device, and the expression operation includes transfer of a visual message to a user."* [**"LCD screen"**]

**With respect to claims 5 and 6,**

*"An apparatus according to claim 3, wherein the display device includes a monitor which displays a message."* [**"LCD screen."** Furthermore, this device can be attached to a personal computer (Cited in the applicant's specification).]

**With respect to claims 7 and 8,**



*"An apparatus according to claim 3, wherein the display device includes an LED."*

**[See Picture. (red/green LED)]**

With respect to **claims 9 and 10,**

*"An apparatus according to claim 1, wherein said expression means includes a sound generating device, and the expression operation includes transfer of an auditory message to a user."* **[See Picture. (red/green LED)]**

With respect to **claims 11 and 12,**

*"An apparatus according to claim 9, wherein the sound generating device includes a loudspeaker."* **[Copy Tower 40 can be hooked up to a personal computer. It is notoriously well known to someone of ordinary skill in the art that a personal computer anticipates this limitation. A personal computer is also cited in the applicant's specification.]**

With respect to **claims 13 and 14,**

*"An apparatus according to claim 1, wherein the operating member is operated to output to said control means a signal for starting the operation of reading out electronic information recorded on the first recording medium and writing the electronic information in the second recording medium, ["Disc Info feature"] and said control means ignores the signal from the operating member until said control means detects that a recording medium is inserted into at least one of the first and second insertion/removal portions and electronic information can be read out or written."* **[Copy Tower 40 can be hooked up to a personal**

**computer. It is notoriously well known to someone of ordinary skill in the art that a personal computer anticipates this limitation. A personal computer is also cited in the applicant's specification.]**

With respect to **claims 15 and 16,**

*"An apparatus according to claim 1, wherein the operating member is operated to output to said control means a signal for starting the operation of reading out electronic information recorded on the first recording medium and writing the electronic information in the second recording medium, ["Disc Info feature"] and said control means ignores the signal from the operating member after said control means detects that a recording medium is inserted into at least one of the first and second insertion/removal portions and electronic information cannot be read out or written." [Copy Tower 40 can be hooked up to a personal computer. It is notoriously well known to someone of ordinary skill in the art that a personal computer anticipates this limitation. A personal computer is also cited in the applicant's specification.]*

## **CONCLUSION**

### **Status of Claims in the Application**

The following is a summary of the treatment and status of all claims in the application as recommended by **M.P.E.P. 707.07(i)**:

**Claims rejected in the Application**

Per the instant office action, claims **1-16** have received a first action on the merits and are subject of a first action non-final.

**Direction of Future Correspondences**

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Horace L. Flournoy whose telephone number is (571) 272-2705. The examiner can normally be reached on Monday through Friday 8:00 AM to 5:30 PM (ET).

**Important Note**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Sparks can be reached on (571) 272-4201. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 746-7239.

Information regarding the status of an Application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or PUBLIC PAIR. Status information for unpublished applications is available through Private Pair only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

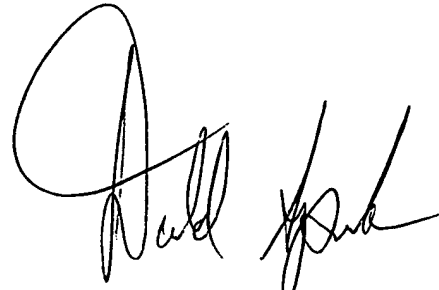
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Horace L. Flournoy

Patent Examiner

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A handwritten signature in black ink, appearing to read 'Donald Sparks', with a large, stylized initial 'D'.

**DONALD SPARKS**  
**SUPERVISORY PATENT EXAMINER**